

REMARKS

I. Introduction

This paper is submitted in response to the non-final Office Action mailed on May 17, 2010.

Claims 3, 5-15, 18, and 20 are pending in the present application and stand rejected. The Applicant respectfully traverses these rejections and submits that the pending claims are patentable, as explained below. Accordingly, the Applicant requests that the U.S. Patent & Trademark Office (the "Office") issue a Notice of Allowance without delay.

II. The Claims are Patentable over Oren and Koka

The Office Action rejected claims 3, 5, 7, 15, 18, and 20 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,539,387 to Oren, *et al.* in view of U.S. Pub. No. 2002/0059459 to Koka, *et al.* The Applicant traverses these rejections for the following reasons.

To establish *prima facie* obviousness, the Office must show, based on evidence of record, that the cited reference discloses or suggests each claimed element **and** that it would have been obvious to modify teachings in the reference to arrive at the claimed invention. See MPEP §§ 2141 and 2143; *KSR Int'l Co. v. Teleflex, Inc.*, 550 US 398, 82 U.S.P.Q.2d 1385, 1395-96 (2007). This showing requires Examiners to determine whether there was an apparent reason to combine elements in references and to articulate that reason. See *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed.

Cir. 2006)).

Specifically, the Office has an obligation to **develop an evidentiary basis for its findings**. *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). The agency is obligated to “make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency’s reasoning in reaching its conclusions.” *In re Lee*, 277 F.3d at 1342. The agency must not only have reached a sound decision, but have articulated the reasons for that decision and the findings that support it. *Id.*

The Applicant submits that the Office failed to establish *prima facie* obviousness at least because (A) the Office failed to make the findings required to support its conclusion that one of ordinary skill would have combined teachings from these references together; and (B) in any event, the combination of Oren and Koka (even if a reason had existed for combining teachings from these references together) fails to disclose each claimed element.

A. **Failure to Make Required Findings to Support Obviousness Conclusion**

The Office failed to articulate a reason supported by an evidentiary basis of why one of skilled in the art would have combined reference teachings and thus the Office failed to establish *prima facie* obviousness.

After setting forth the teachings (according to the Office) of each of Oren and Koka, the Office concluded, “[i]t would have been obvious to a person with ordinary skills in the art at the time of the invention to incorporate the teachings of Koka with the teachings of Oren **for the purpose of utilizing hyperlinks to**

navigate between different documents or between different locations within a document ([Abstract] of Koka)." Office Action, pp. 4-5 (emphasis added).

The bolded portion in the quote from the Office Action appears to be an attempt by the Office to set forth a reason, as required by *KSR* to establish *prima facie* obviousness, of why one of ordinary skill in the art would have combined teachings from Koka and Oren together. However, this is not a reason. The bolded portion in the quote from the Office Action merely states that Koka teaches those features. It provides no reason for one to have combined those features with Oren. Put another way, if one wanted to "utiliz[e] hyperlinks to **navigate between different documents or between different locations within a document**" one would have practiced the teachings of Koka (as interpreted by the Office) independent of Oren.

Merely practicing the teachings of Koka (as interpreted by the Office) is no reason to combine those teachings with another reference.

Furthermore, Oren itself discloses using hypertext nodes. See e.g. Oren, Abstract. Why would one of ordinary skill have a reason to combine teachings from Koka to "utiliz[e] hyperlinks to navigate between different documents or between different locations within a document" when Oren discloses using hypertext nodes?

Accordingly, the Office "has not articulated an adequate rationale as to why, absent hindsight gleaned from [Applicant's] disclosure, a person of ordinary skill in the art would have been prompted to combine the teachings of [the cited references]." *Ex parte Cox*, Appeal 2009-002771 at p. 8 (Board. Pat. App. Int.

March 18, 2010, non-precedential)(*citing In re Kahn*, 441 F.3d at 988).¹

In any event, even if the bolded portion in the quote from the Office Action is a "reason," it is a conclusion only. It is not supported by any findings of fact based on evidence of record, as is required. The Office cites to the Abstract of Koka, but it **does not even support** the statement for which the Office cites. Nothing in the Abstract of Koka relates to "utilizing hyperlinks to navigate between different documents." Instead, the Abstract of Koka describes, "dividing the web page data into segments having a size no greater than said chunk size limit; and linking said chunks in sequence."

For at least these reasons, the Office has failed to establish *prima facie* obviousness. The rejections of claims 3, 5, 7, 15, 18, and 20 should therefore be withdrawn, and the claims should be allowed.

B. The Cited References Fail to Disclose the Claims

Even assuming a reason existed for combining teachings from Koka with those of Oren (which is not conceded as explained above), the combination fails to disclose each element claimed. The combination fails to disclose or suggest at least "establishing a user-executable navigation link from at least one sub-portion of the database to a second sub-portion of the database, the user-executable navigation link permitting a user to navigate from the at least one sub-portion to the second sub-portion, wherein the second sub-portion is non-sequential to the at least one sub-portion," as in claim 3 (claims 15 and 18 include similar requirements).

¹ A copy of *Ex parte Cox* can be accessed via

The Office relied on Koka, for the combination, as disclosing these features. However, Koka does not disclose these features.

Koka fails to disclose any database arrangement, much less the arrangement claimed. Instead, Koka discloses a method for breaking up a web page containing data into limited pages to allow the limited pages to pass through a gateway having a defined gateway limit. See e.g., Koka, Abstract. The web page is divided into the limited pages having a maximum chunk size that is at or below the gateway limit to permit the limited pages to pass through the gateway. See *id.*, at [0019]. The limited pages are linked in sequence to permit the web page to be reconstructed after passing through the gateway. See *id.* at ¶¶ [0026]-[0027].

In contrast, the claims require sub-portions that are subdivisions of databases in which information is then stored.

Furthermore, the limited page size and associations in Koka are based on content and the gateway limit. That is, in Koka the limited pages are determined by gateway limitation and a “break point” which does not fall “within a word.” *Id.* at Abstract. The limited pages, which make up a web page, are linked sequentially. Links can be provided to jump to different portions **of the same web page** in a non-sequential order. Koka, ¶ [0027]. For example, page 40 can be linked to page 40”, which is part of the same web page as page 40, but in a different order.

Koka fails to disclose that links can be provided from a page to another portion of a database that is non-sequential to the part of the database with the portion of the page. Instead, Koka links different pages of the same web page together. The links in Koka ensure that the web page can be reconstructed and that sequential relationships are retained. In contrast, the sub-portions of the claims enable the navigation of the reader through the content to a portion of digression to another group of sub-portions (that are arranged sequentially with each other) and then to return to the original portion of digression.

At least because Koka, for the combination, relates to links portions of the same web page (in order and not in order (e.g. non-sequential) instead of linking different sub-portions of a database together, the combination fails to disclose or suggest each of the elements claimed. Withdrawal of the rejection and allowance of claims 3, 15, and 18 (and claims 5, 7, and 20 at least by dependency) for at least these reasons is kindly requested.

III. Claims 6 and 14 are Patentable

The Office Action rejected claims 6 and 14 under 35 U.S.C. § 103(a) as being obvious over Oren in view of Koka and U.S. Pub. No. 2001/0047358 to Flinn, *et al.* Each of claims 6 and 14 depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 6 and 14 are also patentable. Withdrawal of the rejection and allowance of claims 6 and 14 is kindly requested.

IV. Claims 8-10 are Patentable

The Office Action rejected claims 8-10 under 35 U.S.C. § 103(a) as being obvious over Oren in view of Koka and U.S. Patent No. 6,714,215 to Flora. Each of claims 8-10 ultimately depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 8-10 are also patentable. Withdrawal of the rejection and allowance of claims 8-10 is kindly requested.

V. Claim 11 is Patentable

The Office Action rejected claim 11 under 35 U.S.C. § 103(a) as being obvious over **four different references**: Oren, Koka, Flora, and Flinn. Claim 11 ultimately depends from and further limits claim 3. Reasons for allowance claim 3 are provided above. For at least those same reasons, the Applicant submits that claim 11 is also patentable. Withdrawal of the rejection and allowance of claim 11 is kindly requested.

VI. Claims 12 and 13 are Patentable

The Office Action rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being obvious over **four different references**: Oren, Koka, Flora and U.S. Patent No. 5,761,436 to Nielsen. Each of claims 12-13 ultimately depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 12-13 are also

patentable. Withdrawal of the rejection and allowance of claims 12-13 is kindly requested.

CONCLUSION

The Applicant submits respectfully that all pending claims are in a condition for allowance. If any additional fees are due for this application, the fees may be charged to Deposit Account number 11-0855. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404 745-2520.

Respectfully submitted,

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